

72
No. 2764

IN THE

United States Circuit Court of Appeals

For the Ninth Circuit

CALIFORNIA CANNERIES COMPANY

(a corporation),

Appellant,

vs.

DUNKLEY COMPANY (a corporation),

Appellee.

BRIEF FOR APPELLANT.

ASHER, MEYERSTEIN & McNUTT,

Attorneys for Appellant.

JOSEPH C. MEYERSTEIN,

Of Counsel.

Filed this.....day of May, 1916.

F. D. Monckton
FRANK D. MONCKTON, Clerk.

By.....Deputy Clerk.

No. 2764

IN THE

United States Circuit Court of Appeals

For the Ninth Circuit

CALIFORNIA CANNERIES COMPANY

(a corporation),

Appellant,

vs.

DUNKLEY COMPANY (a corporation),

Appellee.

BRIEF FOR APPELLANT.

Statement of Facts.

Dunkley Company, appellee, as the owner of letters patent, Nos. 1, 104, 175, covering an invention consisting of a combination device for loosening the skin of, and peeling peaches and other fruits, brought an action to enjoin the use by appellant California Canneries Company of a machine used by it for peeling peaches, alleging that the latter infringed its patent; appellant denied infringement. After trial of the case, the United States District Court for the Ninth District, Second Division, made its interlocutory order adjudging that appellant's device infringed said patent, granted an injunction

permanently restraining the use by appellant of its machine, and ordered a reference for the ascertainment of profits and damages. The court found that appellant's machine invaded the patentee's rights, as set forth in and protected by claims Nos. 5, 6, 14, 19, 20, 21, 22, 23, 24, 25 and 26 of its said patent.

In its said letters patent, the inventor describes his invention as follows:

"Be it known that I, Samuel J. Dunkley, a citizen of the United States, residing in Kalamazoo, in the county of Kalamazoo and State of Michigan, have invented a new and useful Improvement in Machines for Peeling Peaches and other Fruit, of which the following is a specification.

"My invention relates to machines for peeling peaches, or other fruit or vegetables.

"The object of my invention is to provide a machine or apparatus of a simple, efficient and durable construction, by means of which peaches, or other fruit or vegetables, may be automatically peeled very rapidly and cheaply, *and without injury to or mutilation of the fruit or the like*, and by which also the skin or peel may be removed without waste of the pulp.

"My invention consists in the means I employ to practically accomplish this object or result; that is to say it consists, in combination with a peel or skin softening, disintegrating or shriveling means or device, preferably consisting of a tank or chamber containing a heated fluid, and a heater for the same, a conveyor for automatically conveying the peaches through the skin softening, disintegrating or shriveling device and subjecting the peaches to its action for *uniform and measured time*, a chute or device for delivering the peaches *in single file line to a brushing and washing mechanism*, and a peach

brushing and washing mechanism, preferably comprising a group of three long perforated pipes for spraying water upon the moving line of peaches, and subjecting them to a water *brushing action*, an endless belt *brush* arranged between the two lowermost perforated pipes and operating to *brush the peaches* as they are rotated and to convey them along, and a pair of oppositely rotating cylindrical brushes operating both to rotate and *brush the peaches*, and having hollow perforated pipe cores for spraying the rotary brushes with water, and rotary cylindrical rubber sponge brushes, also having hollow perforated pipe cores for supplying the same with water; whereby the peaches may be very rapidly and cheaply and perfectly peeled, without waste or injury.

“My invention also consists in the novel construction of parts and devices and in the novel combination of parts and devices herein shown or described.” (Our italics.)

The machine of defendant portrayed in Exhibit 1 consists of a moving wire mesh screen or platform, on to which peaches are dropped or placed, and carried forward between jets or sprays of water, arranged in opposition above and below said screen, and during their passage between the opposed jets, the peaches are exposed to the erosive force of the water which washes or removes the previously disintegrated skin therefrom. The said platform or screen is agitated by mechanical means for the purpose, and with the result of disposing the peaches thereon, in a single layer, and of affecting a complete presentation of their surfaces to the erosive force of the water ejected by the jets.

The peaches before being placed upon the screen are treated in a lye bath or scalding medium, which scalding medium, it is *not claimed forms any part of the peeling machine proper*, or constitutes any element of the infringement. In a word, for the purpose of testing the matter of infringement, it may be considered that peaches, whose skins have been loosened by dipping in lye, are carried to, and by hand placed upon the screen, which automatically starts them in their progressive course through the water batteries, consisting of opposed nozzles. It is the contention of appellant that its machine is in no legal sense the mechanical equivalent of the patented device, notwithstanding each performs the function of removing the loosened skin from peaches; that a patentee may not be heard to abandon necessary elements of his device, and thus bring under the protection of his patent a device robbed of its essential mechanical parts, for the purpose of stopping the use by another of a machine similar to that covered by the patent, only after the latter has been stripped beyond recognition of those mechanical elements which are of the very spirit of the invention. In the patented combination are specified a chute or device for delivering the peaches in *single file line* to a *brushing* and washing mechanism, the fruit being meanwhile supported upon an endless *brush belt*.

The patented combination consists of a tank for scalding fruit, with means for properly timing the exposure thereof to the erosive force of the liquid

in the tank; means to deliver the treated fruit in a special manner, to wit, single file, on to a platform comprising an endless bristle surface, means, namely, brush-rollers rotating in opposite directions, adapted to at once control the orderly advancement of the fruit and uniformly present it to jets of water ejected from perforated pipes parallel to the brushes, and to brush off, as well as wash off, the skin.

In the appellant's machine there are no brushes, no brush platform, no chute to control the manner of introduction of the fruit to the water jets, and no equivalent of the means in the patented device adapted to affecting the orderly advancement and presentation of the fruit to the sprays, and no means to brush or rub off the skin.

In appellant's machine the peaches are presented haphazard to the jets of water, except that the agitator tends to turn all sides of the fruit to the water sprays.

Appellee contends that it is not confined to a construction calling for a brush platform, brushes to turn, or to rub the fruit, or means to effect single file, presentation of the fruit, but that on the other hand its claims, numbered as above, permit the abandonment of all of these specified physical features, with the result that any device which advances fruit on a moving platform, and thus exposes it to peeling jets of water, is an infringement of its patent.

Specification of Errors Relied Upon.

Appellant has with perhaps unnecessary artificiality specified the errors of law upon which it intends to rely, but in their essence they are:

That the court erred in finding that claims numbers 5, 6, 14, 19, 20, 21, 22, 23, 24, 25 and 26 are valid, and erred in finding that the defendant's machine embodies the mechanical equivalent of the patentee's machine, and hence infringed the patent.

Argument.

A patent is to be construed as a contract for the purpose of arriving at its intent and meaning. To ascertain the intent and meaning of a patent, the rules governing interpretation of contracts govern, and the entire instrument, including drawings and specifications, is to be considered in arriving at its intent and meaning.

Hogg v. Emerson, 6 How. 437; 12 Law Ed. 505.

Patents are to be construed to secure to their inventor the real invention he intends to secure by his patent.

Ives v. Hamilton, 92 U. S. 426; 23 L. E. 494.

Appellant contends that when this patent is read in its entirety it assumes to protect more than, and something different from, a machine which by mechanical means merely, effects the exposure of

fruit to water sprays ejected by pipes or nozzles; but rather calls for a combination of parts calculated to advance the fruit in an orderly manner, to present it in a uniform manner, and to brush or rub it while it is being sprayed. In other words, this patent was not intended to cover, and does not cover, a combination for mere water peeling of fruit, the water to be sprayed upon it as it may advance under the spray.

Before determining the matter of whether or not appellant's device infringes the patent in suit, the question must be settled as to what the invention thereby protected consists of. We submit that the device covered by the patent in this case is a mere combination improvement upon means or methods of peeling fruit, and that it involves no element of discovery. Its essence is not in the presentation to the public of the fact or principle that water, played or sprayed upon fruit, which has been treated by lye, will remove the skin. This patent does not represent a pioneer invention, is not original in character, and does not represent the discovery of the erosive force of water as applied to or against a surface. Such invention as is protected by this patent in our view, lies in the method, or combination of means, of applying water to fruit, at the same time handling, manipulating and advancing the fruit in an orderly manner under the water.

The contention of the appellee is that certain of the claims of the patent are so broad as to enable

the patentee to construct his machine in any manner that he desires, so long as such machine performs the office of supporting, turning and advancing fruit while the same is exposed to the force of water jets. Of these general claims, No. 19 may be taken as a type, which reads as follows:

“In an apparatus for treating fruit, such as peaches, means for removing previously disintegrated skin from the fruit, including a support for the fruit, means for effecting a change in the position of the fruit on said support, and means for directing peeling water jets upon said fruit.”

The above claim, and each of the others found to have been invaded, omits all mention of any mechanical means for effecting the orderly advancement of the fruit, and for the control and advancement of it in any particular manner, as the same is exposed to the force of water jets.

Brushes are omitted, or cylinders, consisting of material other than bristles, a bristle platform, or a platform consisting of a material which would perform the office of bristles, chutes for the presentation of the fruit single file; in a word, if the general claims of this patent are to be indulged the force claimed by appellee, a person who rolled, or who caused fruit to be rolled down an inclined platform under a water faucet would necessarily infringe this patent. It will be readily observed from an examination of Exhibits I and II, namely the appellant's device and the patent, respectively, that in the appellant's device any mechanical means

or feature which is calculated to cause the passage of the fruit under the spray in any particular, or controlled or orderly manner, is wanting.

As has been suggested, if the rollers, be they made of bristle or other substance, and the brush platform are not an essential part and of the essence of the invention covered by the patent, then this patentee can practically prevent the washing of fruit in any method other than by hand, upon the theory that it invades his patent.

The strongest argument that might be urged by appellant is the mere presentation for examination of the patent itself. It is an intricate, elaborate and highly specialized piece of machinery, and it seems inconceivable to us that this device, when robbed of all of its mechanical parts can be still said to represent the spirit of the invention, or the actual invention. If the inventor of the telephone, to illustrate, had incorporated in his claims for patent an apparatus which by any means would carry the human voice from one place to another he could with as much reason have sought to stop the use by boys of tin cans the heads of which were connected by a waxed string, upon the theory that such invaded the general claims of his patent, as can this patentee seek to prevent the use by the appellant of a mere platform which carries fruit past, and exposes it to, the force of water ejected from nozzles. It is true that this platform is agitated to turn the fruit over. But an examination of the device, we suggest, must lead to the conclu-

sion that the appellant's device is capable of accomplishing only *accidentally* and *imperfectly*, that which the patented machine is designed to accomplish with completeness, precision and orderliness. It may well be that the appellant's device comes within the letter of the general claims of this patent, but we believe that the language used by the court in the case of *Westinghouse v. Boyden Power Brake Company*, 170 U. S. 537, is applicable in the premises, as follows:

“A device, within the letter of the claims of a patent is not necessarily an infringement, if these, literally construed, do not represent the actual invention.”

And again we urge that the actual invention, as covered by the Dunkley patent, is not a device or a machine for the mere *water* peeling of fruit, but is for a combination of parts which exert certain defined effects upon the fruit, while the same is being sprayed by water.

NO SUBSTANTIAL IDENTITY.

We contend that there is no substantial identity in the character of the two devices, unless by substantial identity is meant every combination which produces the same result and that in this case the differences are substantial and not merely colorable.

Singer Mfg. Co. v. Cramer, 192 U. S. 265.

It certainly may not be said that the device represented by the inventor's drawing and specifica-

tions, or by any claim that describes anything sufficiently to mechanically identify it, is in any sense the mechanical equivalent of the device of the appellant. They have some functional identity in that both machines peel fruit by removing disintegrated skin, with water, but beyond that it is submitted their identity, or even similarity, does not go.

Claims 5, 6, 14, 19 to 26 inclusive, are inconsistent with the real invention embraced in the patent, and hence invalid, as representing a mere attempt to secure to the patentee all peach peeling devices whatsoever, though wholly at variance with, and contrary to, the spirit of the invention. It is submitted that these general claims, if held to be valid, permit the patentee to vary his real invention as circumstances may render expedient. We do not go so far as to contend that the roller brushes, or the bristle platform must be constructed of any specific material, but we do contend, rather, that brushes or cylinders are a necessary part of this invention, as is a platform so constructed as to produce a mechanical rubbing or turning of the fruit. It will be urged doubtless by appellee that these brushes, as a matter of fact, perform no such function as is generally described or known as brushing, because when they become wet they are softened to such an extent that they exert no erosive force on the fruit. This position, however, is inconsistent with the fact that the platform itself is made of bristles, which would overcome the ar-

gument which might be advanced in this regard, for if the bristle platform, so carefully specified and illustrated, in the nature of things performs no function, it would not have found its place in the scheme.

It is respectfully submitted that the device of the appellant does not infringe the invention protected by the patent in suit, even though it may literally infringe claims 5, 6, 14, 19 to 26 inclusive, because these claims, being inconsistent with and not expressing the essence of the invention, cannot have, in law, the effect of securing to the inventor protection for a device for peeling fruit by water by *any means whatsoever*, so long as water jets are included or used. It is therefore respectfully submitted that the decree rendered herein should be reversed.

Dated, San Francisco,
May 10, 1916.

ASHER, MEYERSTEIN & McNUTT,
Attorneys for Appellant.

JOSEPH C. MEYERSTEIN,
Of Counsel.

INDEX.

	Page
Correction of the Statement of the Case.....	1
Argument	2
Patent should be construed as an entire document	2
Claims of patent in suit considered. Action of water jets	3
Decision of Court of Appeals for District of Co- lumbia held Dunkley first.....	4
Defendant's machine	5
Authorities of defendant's brief on infringement considered	5
Dunkley's position supported by recent Supreme Court decisions, applying Westinghouse vs. Boyden	6
Conclusion	7

Authorities:

Continental Paper Bag Co. vs. Eastern Paper Bag Co., 210 U. S. 405; 52 L. Ed. 1122.....	7
Davis Sewing Machine Co. vs. New Departure, 217 Fed. 775	2, 4
Hobbs vs. Beach, 180 U. S. 383, 45 L. Ed. 586...	7
Hogg vs. Emerson, 6 How. 437, 12 L. Ed. 505...	2, 4
Ives vs. Hamilton, 92 U. S. 426, 23 L. Ed. 494....	2, 4
National Tube vs. Mark, 216 Fed. 508.....	3
Scaife vs. Falls City Mills, 209 Fed. 211.....	3
Singer Mfg. Co. vs. Cramer, 192 U. S. 265, 48 L. Ed. 437.....	5
Westinghouse vs. Boyden Power Brake Co., 170 U. S. 537, 42 L. Ed. 1136.....	5, 7

UNITED STATES CIRCUIT COURT OF APPEALS,
FOR THE NINTH CIRCUIT.

CALIFORNIA CANNERIES COM- PANY, a Corporation, Defendant-Appellant, vs. DUNKLEY COMPANY, a Corpora- tion, - Plaintiff-Appellee.	}	In Equity, No. 2764
---	---	------------------------

BRIEF ON BEHALF OF PLAINTIFF-APPELLEE.

Correction of Statement of the Case.

It is not possible to agree entirely with Defendant-Appellant's "Statement of Facts", because it is at fault, particularly about the scope of the claims.

It is said, at page 4 of Appellant's brief:

"In a word, for the purpose of testing the matter of infringement, it may be considered that peaches, whose skins have been loosened by dipping in lye, are carried to, and by hand placed upon the screen", etc.

Claims 5 and 6 of the Dunkley patent embrace in their terms

"the combination with a tank for containing a skin softening and loosening liquid, of a heater therefor, a conveyor passing through the tank for conveying the peaches into, through and out of said liquid,"

as will be seen by reference to such claims. Claim 14 also includes the same features.

The group of claims from 19 to 26 inclusive refer to the treatment of peaches for the removing of **previously** disintegrated skin, and the statement in appellant's brief applies to this group of claims.

ARGUMENT.

Patent Should Be Construed as an Entire Document.

It is easy to agree with the defendant-appellant as to principles of law laid down in **Hogg vs. Emerson**, 6 How. 437, 12 L. Ed. 505, and **Ives vs. Hamilton**, 92 U. S. 426, 23 L. Ed. 494, referred to at page 6 of the brief. The language made use of, particularly in **Hogg vs. Emerson**, is especially pertinent here, the Court saying, toward the bottom of page 485:

"We cannot consent to be over astute in sustaining objections to patents. 4 East, 135; **Crosley v. Beverly**, 3 Car. & Payne, 513, 514. The true rule of construction in respect to patents and specifications, and the doings generally of inventors, is to apply to them plain and ordinary principles, as we have endeavored to on this occasion, and not, in this most metaphysical branch of modern law, to yield to subtilities and technicalities, unsuited to the subject, and not in keeping with the liberal spirit of the age, and likely to prove ruinous to a class of the community, so inconsiderate and unskilled in business, as men of genius and inventors usually are."

This is of high consequence in the proper construction of a patent, and the principle has been very wisely applied by the Circuit Court of Appeals for the Sixth Circuit in

Davis Sewing Machine Co. vs. New Departure,
217 Fed. 775,

Judge Denison, speaking for that Court, saying, at p. 784:

“In determining whether the ambiguous terms of a claim should be confined more or less closely to the form shown in the drawings, it is usually well to compare with other claims which may not be in suit; and if we find other claims which call for the specific construction of a part mentioned more generally in the claims in suit, that will be a persuasive reason for not giving the limited construction to the general terms.”

This is especially pertinent in view of the construction sought to be imposed upon the claims by defendant-appellant.

See also

National Tube vs. Mark, 216 Fed. 508-521;
Scaife vs. Falls City Mills, 209 Fed. 211, at 216.

Claims of Patent in Suit Considered. Action of Water Jets.

It will be noted that there are 26 claims in the patent in suit. Claims 1, 2, 3, 4, 7, 8, 9, 10, 11, 12, 13, 17 and 18 include as elements brushes in one form or another. Claim 15 has to do with the automatic means for delivering the peaches in a single file, and Claim 16 has to do with special arrangements in conjunction with the tank for the softening and loosening liquid, calling for a screen and the like.

So it will be seen that special features urged as features of the Dunkley patent are made the special features of other claims. The description supports the contention of plaintiff-appellee that a **water brushing action** is intended to be claimed, because that phrase is used at line 39 on page 1 of the patent. At page 2, line 28 occurs the description:

"This washing or brushing mechanism comprises a group of, preferably, three water pipes G, having a series of perforations g arranged to strike the peaches as they are conveyed along between the pipes, and thus to impart to the peaches a rotary movement."

Also at line 69, page 2, it is stated:

"The perforated water pipes G G G, preferably extend beyond the rotary brushes K. K¹, so that the water spray may entirely free the surface of the peaches and the like from any particles of skin or peel."

At line 113, page 2, it is said:

"The water peeling means here shown are available wherever the skin of the fruit or vegetable has been suitably disintegrated or loosened."

It will thus be seen that the special claims here insisted upon are justified when the entire document is taken into consideration, according to the rules of law in **Hogg vs. Emerson**, and in **Ives vs. Hamilton**, and as laid down by the Court of Appeals for the Sixth Circuit in **Davis vs. New Departure**.

Decision of Court of Appeals for District of Columbia held Dunkley First.

This interpretation of the claims is entirely in accord with the decision of the Circuit Court of Appeals for the District of Columbia, reversing the decision of the Commissioner of Patents, and allowing the claims.

Counsel will submit copy of that decision with under-scoring in red to facilitate the consideration of the matter.

Copy of the patent will also be submitted with underscoring in red to point out the features indicating the water peeling action in the claims insisted upon, and with underscoring in blue in the claims not insisted upon, so that the special features thereof will at once be appreciated and stand out.

Defendant's Machine.

Considering the drawing of defendant's device, there is seen to be a tank B, conveyor means C, an endless belt F of spiral webbing of half-inch mesh, spray nozzles above and below, and revolving agitators H for shaking the belt, constituting "means for effecting a change of position of the fruit on said support."

The defendant's machine constitutes everything called for in the various claims in suit. There is the endless conveyor: it has not any brush, but the distinction between claim 6, sued upon, and claim 7 is that the "endless conveyor" referred to in the third line from the bottom of the claim 6, is specified as "an endless conveyor brush" in the third line from the bottom of claim 7.

It thus is very clear that the terminology of Claim 6 was especially to hold a conveyor of the type appearing in defendant's machine. A reference to all of the other claims, in view of this explanation, will show every element present, operating in the same way to produce the same results. Infringement is clear.

Authorities of Defendant's Brief on Infringement Considered.

Defendant-appellant has dwelt to a considerable extent upon the law as laid down in **Westinghouse vs. Boyden**, and in **Singer Mfg. Co. vs. Cramer**. In both these cases there was an anticipatory art, and in both cases the defendant's structure operated by an entirely different

means from that specified in the patent. Therefore, such decisions cannot be considered pertinent here, because their rules cannot be applied.

The Court of Appeals for the District of Columbia in passing on this structure said:

“Dunkley was the first to invent and put into practice a rapid and effective machine for peeling peaches.”

Nothing in this record contravenes that statement. A reference to the testimony shows that a machine would do on the average 18,000 to 20,000 bushels a season,—see Supplemental Transcript of Record, p. 11; that is, hundreds of bushels a day, as a matter of fact. And machines of this principle have been used by practically every canner in the country.

The invention of the Dunkley machine was revolutionary in its character. There is nothing appears in this record to anticipate any part of the invention, much less the particular combination of means recited. The case was definitely passed on in open court trial by the Court below, who had opportunity to satisfy himself as to the statements of any and all witnesses and as to all details. We submit that his decision is entitled to the highest respect for this reason, and also for the further reason that there is absolutely nothing in the record that shows any reason or grounds for any different conclusion.

Dunkley's Position Supported by Recent Supreme Court Decisions, Applying *Westinghouse vs. Boyden*.

The position of Plaintiff-Appellee as to the construction of the Dunkley patent and as to the infringement by Defendant's structure, is abundantly supported by recent Supreme Court decisions. The claims of the Dunkley patent are not for a function but for mechanical means. See

Continental Paper Bag Co. vs. Eastern Paper
Bag Co., 210 U. S. 405, at p. 442;
52 L. Ed. 1122, at 1129;

Hobbs vs. Beach, 180 U. S. 383, 45 L. Ed. 586,

The principle of law in the latter case is thoroughly discussed beginning at p. 400 of the U. S. Report, p. 595 of Lawyers Edition. **Westinghouse vs. Boyden Power Brake Co.** is applied in this case and its doctrine fully explained.

The decree of the Court below should be affirmed, the injunction should be enforced, and the accounting of profits and damages proceeded with, at the cost of defendant-appellant.

Respectfully submitted.

FRED L. CHAPPELL,

JOHN H. MILLER,

Counsel for Plaintiff-Appellee.